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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1968

No. 415

ROBERT J. EBBERT
and
DESIGN PRODUCTS CORPORATION
Petitioners
v.
EDWARD J. BRENNER, COMMISSIONER
OF PATENTS
Respondent

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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WO. 2-8745—WO. 2-8732

## SUBJECT INDEX


| | Page |
|---|---|
| Petition for Writ of Certiorari | 1-11 |
| Opinions Below | 2 |
| Jurisdiction | 2 |
| Question Presented | 2 |
| Constitutional Provisions and Statutes Involved | 3 |
| Statement of the Case | 4-5 |
| Reasons why the Writ Should be Granted | 6-11 |
| Conclusion | 11 |
| Appendix A—Opinion of First Assistant Commissioner of Patents | 13-14 |
| B—Opinion of the Court (U. S. Dist. Court for District of Columbia), and Judgment | 15-17 |
| C—Opinion of U. S. Court of Appeals—District of Columbia Circuit, and Judgment, reversing | 18-25 |
| D—Composite Copy of Complaint and Answer, attached to Petitioner's Motion for Summary Judgment | 26-31 |

## INDEX TO AUTHORITIES CITED


**Cases:** Page

Allen v. Werner, 190 F.2d 840, CA 5 (1951) ..... 7

Buchanan v. Warley, 245 US 60, 38 S. Ct. 16, 62L Ed 149 (1917) ..... 7

Commissioner v. Hopkinson, 126 F.2d 406, CA2 (1942) ..... 7

Covey v. Somers, 351 US 141, 76 S. Ct. 724, 100L Ed 1021 (1955) ..... 6

Edward C. Meyers, 6 T. C. 258 ..... 7

Hartford Empire Co. v. United States, 323 US 386; 65 S. Ct. 373, 89L Ed 322 (1944) ..... 7

Lambert v. California, 355 US 225, 78 S. Ct. 240, 2L Ed 228 (1957) ..... 6, 8

Merck & Co. v. Smith, 261 F.2d 162, CA 3 (1958) 7

Morgan v. United States, 304 US 1, 58 S. Ct. 773, 82L Ed 129 (1937) ..... 9

Mullane v. Central Hanover Trust Co., 339 US 306, 70 S. Ct. 652, 94L Ed 865 (1949) ..... 6, 8

**Statutes:**

U. S. Code:

Title 5, Secs. 701-706 ..... 4, 5

Title 26, Section 1235 ..... 7

Title 28, Section 1254(1) ..... 2

Title 28, Section 1331 ..... 5

| | Page |
|---|---|
| Title 28, Section 1361 | 4, 5 |
| Title 28, Section 2101(c) | 2 |
| Title 35, Section 133 | 3, 5, 9, 10, 11 |
| Title 35, Section 151 | 2, 3, 4, 6, 10, 11 |
| Title 35, Section 264 | 7 |

**Constitution of the U. S.:**

| | |
|---|---|
| Fifth Amendment | 3 |

**Miscellaneous:**

| | |
|---|---|
| H.R. Rep No. 2543, 83 Cong. 2d Sess. 70, 1954 | 7 |
| Sen. Report No. 1622, 83 Cong. 2d Sess. 439, 1954 | 7 |

IN THE

# Supreme Court of the United States

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Petitioners
v.
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OF PATENTS
Respondent

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Robert J. Ebbert and Design Products Corporation pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on May 23, 1968.

## OPINIONS BELOW

The opinions of the Commissioner of Patents (JA 36, 37) and of the United States District Court for the District of Columbia (JA 131-133) have not been reported. That of the United States Court of Appeals for the District of Columbia Circuit has been reported only at 157 USPQ 609. All three opinions, together with the judgments of the courts below, are appended to this petition as Appendices A, B and C respectively.

## JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia Circuit sought to be reviewed was dated and entered on May 23, 1968. There has been no order respecting a rehearing and no order granting an extension of time within which to petition for certiorari. Jurisdiction of this Court is invoked under Title 28 USC, Sections 1254(1) and 2101(c).

## QUESTION PRESENTED

Did the Commissioner of Patents deprive petitioners of property without due process of law by declaring petitioners' allowed application for patent irrevocably forfeited for failure of petitioners to make timely payment of the issue fee, where the petitioners were unaware of the default due to an error which the Commissioner acknowledges was unavoidable and the Commissioner failed to give the customary notice of default within the three months grace period for late fee payment provided by Title 35 USC, Section 151?

## CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

Constitution of the United States, Fifth Amendment:

> "No person shall be . . . deprived of . . . property without due process of law."

Title 35, USC, Section 133, Act of July 19, 1952, c. 950, Sec. 1, 66 Stat. 801:

> "§133. Time for prosecuting application
>
> "Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commission that such delay was unavoidable."

Title 35 USC, Section 151, as amended July 24, 1965, Pub. L. 89-83, Sec. 4, 79 Stat. 260:

> "§151. Issue of patent
>
> "If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.
>
> "Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.
>
> • • • • •
>
> "If any payment required by this section is not timely made, but is submitted with the fee for delayed payment within three months after the due date and sufficient cause is shown for the late payment, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred."

## STATEMENT OF THE CASE[1]

This is an action under the Administrative Procedure Act, Title 5 USC, Sections 701-706; and Title 28 USC, Section 1361 seeking an order directing the Commissioner of Patents to revive an application for patent which had been abandoned because of a delay in paying the issue fee.

Petitioner Robert J. Ebbert applied for a patent, the application being assigned to petitioner Design Products Corporation. After examination procedure, the respondent, Commissioner of Patents, sent a "Notice of Allowance and Issue Fee Due" which was received by petitioners' attorney. Due to what the Commissioner agrees was an unavoidable error petitioners' attorney paid the issue fee in another allowed application in the belief that it was being paid in the application here involved. As a result, the issue fee in this case was not paid within the three months provided by law or the additional three months grace period during which the Commissioner could have accepted it "upon sufficient cause shown" under the authority of 35 USC 151. The Patent Office failed to send the usual notice to petitioners or their attorney of the fact that the fee had not been paid or that the application had become abandoned after the first three months period.[2] As a result of this failure petitioners did not discover the default within the three months additional grace period.

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[1] The facts herein stated are not disputed and are largely set forth in the composite copy of the complaint and answer filed in this case which was attached to petitioner's Motion for Summary Judgment (JA 27-33) and is Appendix D of this Petition.

[2] See Notices (JA 23-26) which are representative notices of this type given in other allowed applications before and after the default in the present case.

Petitioners' attorney, upon discovering the error, promptly tendered the issue fee and petitioned the Commissioner to revive the abandoned application. In support of the petition petitioners asserted that the delay was "unavoidable" within the meaning of 35 USC 133 and that therefore the application should be revived. The Commissioner, while agreeing that petitioners had shown that the delay was "unavoidable," held that Section 133 did not apply to the payment of issue fees, and refused the tendered issue fee on the ground that he had no statutory authority to accept it once the grace period provided in Section 151 had expired.

Suit was brought by petitioners against the Commissioner in the United States District Court for the District of Columbia. Jurisdiction was founded on Title 5, USC, Sections 701 through 706 and Title 28 USC, Sections 1331 and 1361. The suit requested the Court to direct the Commissioner to accept the late tender of issue fee and grant the patent on the ground that he had authority to do so under 35 USC, Section 133 and also because failure to do so would deprive the applicant of a valuable property right in violation of the Fifth Amendment of the United States Constitution.

The District Court held that 35 USC 133 applied to cases of unavoidable delays in the payment of issue fees and granted petitioners' motion for summary judgment. The respondent appealed to the United States Court of Appeals for the District of Columbia Circuit.

The Court of Appeals reversed, holding that 35 USC 133 does not apply to the payment of issue fees but only to actions taken by an applicant prior to allowance of his application. It also held that the original Notice of Allowance and Issue Fee Due satisfied the requirements of due process because it contained the statement that "payment must be made within three months of the date of this Notice or the patent will become abandoned (forfeited)."

## REASONS WHY THE WRIT SHOULD BE GRANTED

The writ should be granted to settle an important question and to correct an erroneous judgment which is in conflict with the principles of due process enunciated by this court in such cases as *Lambert v. California*, 355 US 225, 78 S. Ct. 240, 2L Ed. 2d 228 (1957); *Covey v. Somers*, 351 US 141, 76 S. Ct. 724, 100L Ed. 1021 (1955) and *Mullane v. Central Hanover Trust Co.*, 339 US 306, 70 S. Ct. 652, 94L Ed. 865 (1949). Prior to this case, neither this nor any Court has ruled upon the question of whether the requirements of due process must be satisfied before an allowed application for patent is forfeited for a delay in paying the issue fee.

While the specific question presented can arise only in Patent Office proceedings, the principle involved is applicable to a much wider range of administrative proceedings. To put the question in its broadest aspect, it might be stated thus:

> May property be forfeited for default in payment of a fee without notice of the default and an opportunity to be heard and to rectify an excusable default?

In the patent field alone the question is an important one that is likely to arise with considerable frequency in view of the short period allowed by statute[3] for payment of final fees and the undeniable fact that to err is human. Public interest does not require that valuable rights be put at risk on such an arbitrary and harsh basis.

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[3] Section 151 Title 35 USC was amended by the Act of July 24, 1965, Public Law 89-83, 79 Stat. 260, effective October 24, 1965, to reduce the time for payment of the issue fee from six months to three months and the grace period for late payment from twelve months to three months.

At the threshold, there can be no real basis for the doubt expressed by the Court of Appeals that ownership of an allowed application for patent is a property interest protected by the due process clause. Certainly an issued patent is property so protected, *Hartford Empire Co. v. United States*, 323 US 386, *415*; 65 S. Ct. 373, 89L Ed. 322, *362-3* (1944). See also 35 USC 261. At very least, ownership of an allowed application represents a right to acquire property, which is one of the attributes of property protected by the due process clause of the Fifth Amendment. *Buchanan v. Warley*, 245 US 60, *74*, 38 S. Ct. 16, 62L Ed. 149, *161* (1917). The patent statutes (35 USC 261) provide for the assignment of applications for patents, and the Internal Revenue Code, Title 26 USC, Section 1235 treats gains made on the sale of patent applications as capital gains realized on the sale of property. When this section was enacted (August 16, 1954, c. 736, 68A Stat. 329) the Joint Conference Report indicates that the conferees changed the clause "all substantial rights evidenced by a patent" to "all substantial rights to a patent" to make clear that the section applies to transfers prior to the issuance of a patent (H. R. Rep. No. 2543, 83 Cong. 2d Sess. 70, 1954). The Senate Report on the bill also makes clear that it was intended to apply to pending applications (Senate Report No. 1622, 83 Cong. 2d Sess. 439, 1954).

Finally, transfers of patent applications which do not meet the requirements of 26 USC 1235 are treated as sales of property held by the taxpayer under the general capital gains provision of the tax law. *Merck & Co. v. Smith*, 261 F.2d 162, CA 3 (1958); *Edward C. Meyers*, 6 T. C. 258; *Allen v. Werner*, 190 F.2d 840, CA 5 (1951), and *Commissioner v. Hopkinson*, 126 F.2d 406, CA 2 (1942).

The decision of the Court below is in clear conflict with the decisions of this Court to the effect that the Fifth Amendment of the Constitution prohibits forfeiture of valuable property rights for mere failure to act unless the owner is given notice of the failure or of the existence of conditions which place his property in jeopardy and an opportunity to be heard. This requires that he be given an opportunity to explain or rectify an excusable lapse. In *Lambert v. California*, 355 US 225, *228* (1957) this Court said:

> "Engrained in our concept of due process is the requirement of notice. Notice is sometimes essential so that the citizen has the chance to defend charges. Notice is required before property interests are disturbed, before assessments are made, before penalties are assessed. Notice is required in a myriad of situations where a penalty or forfeiture might be suffered for mere failure to act."

The Court of Appeals ruling, that the original Notice of Allowance fulfilled the requirements of due process merely because it stated that "payment must be made within three months of the date of this notice or the patent will become abandoned (forfeited)," is in direct conflict with the decision in *Mullane v. Central Hanover Bank & Trust Co.*, 339 US 306 (1949) in which this Court held that merely sending beneficiaries of a trust account copies of a statute which permitted notice of judicial settlement of the account by newspaper publication, would not satisfy the requirements of due process, in the absence of actual notice that steps were being taken affecting their interests. This Court said:

> "An elementary and fundamental requirement of due process in any proceeding which is to be accorded finality is notice reasonably calculated under all the circumstances, to apprise interested parties of the *pendency of the action* and afford them an opportunity to present their objections." (Emphasis supplied.)

The language in the Notice of Allowance (JA 54) referring to abandonment merely repeats the statutory language, as did the original notice in the Mullane case. Both were prospective only, and neither satisfied the constitutional requirement of adequate notice because neither gave notice of the event that *had occurred* and which put the property rights at risk. A somewhat analogous situation was dealt with by this Court in *Morgan v. United States,* 304 US 1, 58 Sup. Ct. 773, 82 L Ed. 1129 (1937) in which the initial notice of hearing was held insufficient in the absence of specific notice of the basis for the threatening action.

The original Notice of Allowance (JA. 54) is merely a printed form which is so commonplace in the operations of a busy patent practitioner that it is treated merely as a notice that the issue fee is due, which sets in operation the administrative and clerical acts required to effect payment. It cannot serve to alert anyone to an unintended and unknowing default in payment, which can easily occur through clerical error or loss in the mail.

If the Court of Appeals decision is allowed to stand, the mere mailing by the Patent Office of the Notice of Allowance will start the running of the period for paying the issue fee even if this notice is lost in the mail and is never received by the applicant, and after the six months has expired the Commissioner of Patents would have absolutely no authority to accept the issue fee and applicant's patent rights would be forever lost, regardless of whether any Notice of Default was sent and irrespective of the cause of delay in payment. This is certainly not "due process."

Petitioner urged below, and the District Court agreed, that 35 USC, Section 133 is also applicable to the payment of issue fees. This remedial section of the statute permits

the Commissioner of Patents to revive an abandoned application if it is shown to his satisfaction that a delay in prosecuting the application after "any" action therein was "unavoidable". By this section Congress has provided the essentials of due process. The Commissioner has conceded that the delay was unavoidable within the meaning of Section 133 if it applies, and thus petitioners are entitled to its benefit.

Even if 35 USC, Section 133 does not apply to the payment of issue fees, this Court is not powerless to insist on compliance with Constitutional standards. The Commissioner of Patents has the inherent duty and authority to see that the Constitutional safeguards against deprivation of property are preserved for owners of allowed patent applications by the procedures that he employs. To be consistent with the principles enunciated by this Court, his duty should take the form of either (1) a specific notice of default to the applicant within the grace period provided by law (35 USC 151) for late acceptance of the issue fee,[4] or (2) if no such notice is given, an opportunity for the applicant to explain the reasons for delay in payment beyond the grace period, analogous to the safeguard found in Section 133 for non-allowed applications. Coupled with this inherent right of the Commissioner should be his authority to accept late payment of the fee, either within the grace period if adequate notice is given, or outside the grace period if no notice is given and an adequate showing made.

Such a ruling by this Court would not in any way impair the intent of Congress in expediting the issuance of

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[4] It is now and has been the custom of the Commissioner of Patents to give such a notice but none was given in this case due to an unusually heavy workload during the brief period which was critical to this case (JA 50-51).

patent applications and thus making new technology available to the public at an earlier date. This purpose is accomplished by the 1965 Amendment to Section 151, in the usual case. It would be unreasonable to conclude that Congress, although willing to be liberal in excusing unavoidable delay in prosecuting rejected applications under 35 USC 133, intended to brush aside the safeguards of the due process clause and deny the Commissioner of Patents the right to accept a late issue fee in an allowed application where the delay is equally excusable.

## CONCLUSION

For the foregoing reasons, this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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Of Counsel:

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Detroit, Michigan 48202.

August 13, 1968.

## APPENDIX A

U.S. DEPARTMENT OF COMMERCE
Patent Office
Washington, D.C. 20231

March 2, 1967

Re: Application of
Robert J. Ebbert
Serial No. 308,411
Filed September 12, 1963
For: Mounting Frame for
Electronic Components

On Petition

This is a petition, filed February 10, 1967, for the late acceptance of the issue fee in the above-identified application in which a notice of allowance was mailed April 14, 1966. The showing submitted would justify acceptance of the fee except for the fact that neither the fee nor the petition was filed within three months after the date when the fee was due (July 14, 1966), as required by 35 U.S.C. 151. Notwithstanding the arguments ably advanced by the petitioner it is considered that the express language of that section clearly prohibits the Patent Office from accepting an issue fee which is first tendered more than three months after it is due.

It is the petitioner's contention that an application in which the fee is not timely paid is abandoned and may be revived upon a showing of the type contemplated by 35 U.S.C. 133, regardless of the lapse of time. It is not thought, however, that the payment of the issue fee constitutes prosecution of the application within the meaning of section 133, which refers to times of six months or "not

less than thirty days as fixed by the Commissioner," whereas the three month period for payment of the issue fee is fixed by the statutes and the Commissioner could not reduce it to thirty days. Moreover, if section 133 were intended to apply to late payment of the issue fee, there is no apparent reason why a separate and different provision for the same payment should have been incorporated in section 151.

Finally, even assuming that a case in which the issue fee is not timely paid could be regarded as an abandoned application under section 133, it is not seen that this would strengthen the petitioner's position. There is nothing in that section which is inconsistent with the express provision of section 151 that revival of a case which has become abandoned through failure to pay the issue fee can be effected only if the fee is presented within three months after it is due. This might properly be regarded as an additional limitation to section 133, applying to that particular type of abandoned case. Section 133 does not state that there can never be a limit to the time within which a petition to revive must be filed.

It would appear that the interpretation urged by the petitioner would render the fourth paragraph of section 151 entirely meaningless and superfluous, and it is not thought that such an interpretation should be adopted unless no other reasonable one is possible.

It is held that the Patent Office is without jurisdiction to accept the issue fee in this case and the petition is accordingly dismissed.

Edwin L. Reynolds
First Assistant Commissioner

Harness, Dickey and Pierce
700 Fisher Building
Detroit, Michigan 48202

## APPENDIX B

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

Civil Action 614-67

Robert J. Ebbert, Et al, Plaintiffs,

v.

Edward J. Brenner, Commissioner of Patents, Defendant.

Washington, D.C.
September 8, 1967.

The above cause came on hearing of motion for summary judgment before the Honorable Alexander Holtzoff, United States District Judge.

Appearances:

For the Plaintiffs: John A. Blair, Esq., Richard E. Dibner, Esq.

For the Defendant: Samuel W. Cochran, Esq. Patent Office Solicitor.

[2] OPINION OF THE COURT

The Court: Title 35, United States Code, Section 151 provides for the payment of a fee for a patent after notice of allowance has been issued to the applicant. The last sentence of that section provides that if any payment required by this section is not timely made but is submitted with the fee for delayed payment within three months after the due date and sufficient cause is shown for the

late payment, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

The Solicitor for the Patent Office very cogently and ably argues that that section is exclusive and that therefore, unless a fee is tendered within three months after the due date, it cannot be accepted subsequently, no matter what the excuse.

However, Section 133 provides that upon failure of the applicant to prosecute the application within six months after any action therein of which notice has been given or mailed to the applicant, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

It is the view of this Court that the prosecution of [3] an application is not completed until the fee is paid and the patent issues; it is not concluded at the time of the allowance of the patent.

Therefore, Section 133 is equally applicable to the situation presented in this case and therefore the provision of Section 151 is not exclusive.

Under the circumstances, it is open to the applicant to show that the delay in paying the fee was unavoidable.

The admitted facts in this case are that the failure to pay the fee in time was an inadvertent clerical error in the office of a busy law firm. To deprive people of valuable rights for such an error seems an unwarranted hardship.

The Court is of the opinion that Section 133 is applicable, as well as Section 151, and they are not mutually exclusive and the applicant has a remedy under either section.

As the Court understands it, it is not disputed that if Section 133 is applicable the plaintiff is entitled to relief,

and accordingly, the plaintiffs' motion for summary judgment is granted.

You may submit an order.

REPORTER'S CERTIFICATE

Certified as the official transcript of proceedings.

Gerald Nevitt.

JUDGMENT

The above cause having come on before the court on this 8th day of September, 1967, on the Plaintiffs' Motion for Summary Judgment and Defendant's Motion for Summary Judgment and the parties thereto having been heard:

It Is Hereby Ordered, Adjudged and Decreed that

1. The Defendant's Motion for Summary Judgment be denied,

2. The Plaintiffs' Motion for Summary Judgment be granted, and the action of defendant in dismissing Plaintiffs' Petition to Revive the abandoned application of Robert J. Ebbert, Serial No. 308,411, filed September 12, 1963, for Mounting Frame for Electronic Components is hereby set aside, and

3. The defendant be and he is hereby ordered to revive said abandoned application pursuant to the provisions of Title 35 USC Section 133, accept the issue fee which has been tendered, and issue Letters Patent on said application to plaintiff Design Products Corporation as assignee of Robert J. Ebbert.

Alexander Holtzoff,
*U. S. District Judge.*

Date: September 18, 1967.

## APPENDIX C

UNITED STATES COURT OF APPEALS
For the District of Columbia Circuit

No. 21,346

Edward J. Brenner, Commissioner of Patents,
Appellant

v.

Robert J. Ebbert and Design Products Corporation,
Appellees

Appeal from the United States District Court
for the District of Columbia

Decided May 23, 1968

*Mr. S. William Cochran,* Attorney, United States Patent Office, with whom *Mr. Joseph Schimmel,* Solicitor, United States Patent Office, was on the brief, for appellant.

*Mr. John A. Blair,* with whom *Mr. John W. Malley* was on the brief, for appellees. *Mr. William K. West, Jr.,* also entered an appearance for appellees.

Before Bazelon, *Chief Judge,* and Wright and Tamm, *Circuit Judges.*

Tamm, *Circuit Judge:* This case concerns a question of procedure in the Patent Office. After applying for a patent, appellee Ebbert received from the Patent Office a notice of allowance, dated April 21, 1966. It was captioned "NO-

TICE OF ALLOWANCE AND ISSUE FEE DUE," and among other things stated: "With the allowance of the application, the above indicated Issue Fee becomes due and payment must be made *within three months of the date of this Notice or the Patent will become abandoned (forfeited).*" (Emphasis supplied.) Joint Appendix at 54. The issue fee was not paid within three months because of a clerical error on the part of appellees' counsel. On February 10, 1967, appellees tendered the fee, but appellant Commissioner of Patents rejected the tender on the ground that he had no authority to accept the fee after October 21, 1966, *id est,* more than an *additional* three months after the due date of July 21, 1966, set in the notice of allowance. The Patent Office practice had been—and is now—to send applicants a "NOTICE OF FORFEITED APPLICATION" when the issue fee was not paid within the initial three month period after issuance of the notice of allowance. However the practice was suspended from August 4, 1966 until March 1, 1967, as a result of an unusually heavy workload, and no such notice was sent to appellees.

When they tendered the fee, appellees petitioned the Commissioner to revive the abandoned application. The Commissioner dismissed the petition and appellees brought suit in the District Court to set aside that dismissal. They also sought to compel revival, acceptance of the issue fee and issuance of a patent. Cross motions for summary judgment were made, appellee's motion was granted and this appeal was taken.

Two statutes, 35 U.S.C. §133 (1964) and 35 U.S.C. §151 (Supp. II, 1965-66), are involved. They provide:

> §133. Time for prosecuting application
>
> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the ap-

plicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

§151. Issue of patent

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment within three months after the due date and sufficient cause is shown for the late payment, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

The fourth paragraph of §151 specifically authorizes the Commissioner to accept issue fees if they are tendered with a fee for delayed payment, "within three months after the due date . . ." and if "sufficient cause is shown for the late payment . . . ." Thus it is clear that the section does not authorize acceptance of the issue fee here, tendered

more than six months after the due date. Appellees argue —and the District Court found—that §133 allows the acceptance of issue fees without time limitation, if the more strict standard of "unavoidable delay" is met.[1] This position is premised on a conclusion that that section's phrase "prosecute the application" encompasses all action taken by an applicant up to and including securing issuance of a patent. The Commissioner says the two sections are mutually exclusive, that §151 is clearly applicable and that he has no authority to accept the issue fee more than three months after the due date.[2] We agree.

A stated purpose of the 1965 amendments to §151 was "to expedite the prosecution of patent applications and thus make new technology available to the public at an earlier date." S. Rep. No. 301, 89th Cong., 1st Sess. 1 (1965). The prior time limit fixed the due date for payment of the issue fee at six months after the notice of allowance but authorized the Commissioner to accept late payment for one year after the due date. The 1965 amendments modified these time limits, making the due date three months after the notice of allowance and authorizing the Commissioner to accept the fee for an additional three months after the due date on a showing of "sufficient cause." (The statute did not theretofore require such a showing.) If §133 were construed as allowing an abandonment to be revived at any time, the purpose of hastening the beginning—and hence the expiration—of the seventeen year monopoly period would be frustrated.

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[1] It was conceded that appellees' delay in tendering the issue fee was "unavoidable." Joint Appendix at 19.

[2] Although their validity is not in issue, Patent Office intraoffice procedures clearly construe §151 as being exclusively applicable to the late payment of issue fees. *See* Manual of Patent Examining Procedure §712 (current ed.).

Sections 133 and 151 are contained in separate chapters of Title 35. Chapter 12, titled "Examination of Application," contains §133, while Chapter 14, titled "Issue of Patent," contains §151. This dichotomy is strong evidence that the phrase "prosecute the application" in §133 comprehends only action taken by an applicant through gaining allowance of his application, because examination of the application is completed at that point. Congress established a separate statutory framework for what remains —issuance of the patent. It is a relatively ministerial act; if the issue fee is timely tendered, the patent must issue.

Because little legal work of consequence is involved in tendering the issue fee, there is no need for an unlimited time within which to "respond." Thus there is nothing inherently unreasonable in §151 and its requirement that the issue fee be paid within three months after the due date. In contrast, it is not uncommon before an application is allowed for considerable legal work requiring substantial amounts of time and attendant delays to be involved. For all the foregoing reasons, we hold §151 to be exclusively applicable to this situation.

We are now confronted with appellees' contention that if §151 is exclusively applicable it deprives them of property without due process of law. Such a deprivation requires two elements: 1) the application here, though a patent had not been issued, must have amounted to a property right and 2) deprivation of the right following the notice given here must have denied appellees due process.

We have considerable doubt whether appellees' allowed but unissued patent is "property" as that term is used in the fifth amendment. See for example, *DeFerranti v. Lyndmark*, 30 App. D.C. 417, 425 (1908) where we noted that "in a patent, no vested right of which the applicant cannot be deprived is acquired under the preliminary pro-

ceedings leading up to its issuance. The condition, however, is different after the patent is issued." Also in *Mullins Mfg. Co. v. Booth*, 125 F.2d 660, 664 (6th Cir. 1942), the court said: "The right of Booth to his invention while his application is pending is an inchoate right, which matures as property when the patent issues, and it may have great prospective value."

Assuming for the sake of argument, however, that a property right exists here, we conclude that the notice fully satisfied due process requirements. Those requirements were spelled out by the Supreme Court in *Mullane v. Central Hanover Bank & Trust Co.*, 339 U.S. 306, 314-15 (1950):

> An elementary and fundamental requirement of due process in any proceeding which is to be accorded finality is notice reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections. *Milliken v. Meyer*, 311 U.S. 457; *Grannis v. Ordean*, 234 U.S. 385; *Priest v. Las Vegas*, 232 U.S. 604; *Roller v. Holly*, 176 U.S. 398. The notice must be of such a nature as reasonably to convey the required information, *Grannis v. Ordean, supra*, and it must afford a reasonable time for those interested to make their appearance, *Roller v. Holly, supra*, and *cf. Goodrich v. Ferris*, 214 U.S. 71. But if with due regard for the practicalities and peculiarities of the case these conditions are reasonably met, the constitutional requirements are satisfied.

The Commissioner's notice specifically stated that "payment must be made within three months of the date of this Notice or the Patent will become abandoned (forfeited)." Appellees concede it was received. Indeed they

*responded* to it by paying the issue fee in another pending application, because of a clerical error. The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

The judgment of the District Court appealed from is reversed.

*Reversed.*

UNITED STATES COURT OF APPEALS

For the District of Columbia Circuit

No. 21,346 September Term, 1967
Civil 614-67

Edward J. Brenner, Commissioner of Patents,
Appellant.

v.

Robert J. Ebbert and Design Products Corporation,
Appellees.

Appeal from the United States District Court for the District of Columbia.

Before: Bazelon, Chief Judge, and Wright and Tamm, Circuit Judges.

JUDGMENT

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel.

On consideration whereof It is ordered and adjudged by this Court that the judgment of the District Court ap-

pealed from in this cause be, and it is hereby, reversed, and that this cause be, and it is hereby, remanded to the District Court for proceedings not inconsistent with the opinion of this Court.

Per Circuit Judge Tamm.

Dated: May 23, 1968.

## APPENDIX D

### EXHIBIT E

Composite Copy of Complaint and Answer as Amended

*Complaint*

1. This action arises under Title 5, USC, Section 701 through 706; Title 28, USC, Sections 1331 and 1361; Title 35, USC, Section 133, and the Fifth Amendment to the Constitution of the United States, as hereinafter more fully appears. The matter in controversy exceeds, exclusive of interest and cost, the sum of Ten Thousand Dollars ($10,000.00).

*Answer*

1. Defendant admits the allegation that the case arises under Title 5, USC, Sections 701 through 706 and Title 28, USC 1361. Defendant denies the allegations of this paragraph of the complaint that this action arises under Title 35 USC, Section 133, Title 28, USC, Section 1331, of the Fifth Amendment to the Federal Constitution. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations regarding the amount of money involved, and therefore, defendant denies said allegations.

*Complaint*

2. Plaintiff Robert J. Ebbert is the inventor and plaintiff Design Products Corporation is the owner of record of United States Patent Application Serial No. 308,411, filed September 12, 1963, by said Robert J. Ebbert for Mounting Frame for Electronic Components. Plaintiffs having complied with the requirements of law, defendant

on April 21, 1966, mailed to plaintiffs a notice of allowance of said patent application, together with notice that an issue fee of $124 must be paid to the Patent Office within three months of the date of said notice of allowance, i.e. by July 21, 1966.

*Answer*

2. Admitted.

*Complaint*

3. The issue fee was not paid within said three months and the aforesaid application became abandoned by operation of law on July 21, 1966.

*Answer*

3. Admitted.

*Complaint*

4. The failure to pay said issue fee was unavoidable and was due to a clerical error which resulted in the payment of the fee due in another pending application in the belief that the payment of the fee due in said application Serial No. 308,411 was being made, in consequence of which neither plaintiffs nor their attorneys were aware of the default in paying said fee or aware of the abandonment of said application until February 2, 1967, on which date the error was first noted.

*Answer*

4. Defendant admits that allegations analogous to those made in this paragraph of the amended complaint were made by plaintiffs in the "Petition to Revive Abandoned Application", referred to in paragraph 6 of the amended complaint.

*Complaint*

5. Defendant gave plaintiffs no notice of plaintiffs' default in paying said issue fee and no notice of the abandonment of said application Serial No. 308,411; although prior to the effective date (October 24, 1965) of the 1965 amendment of 35 USC, Section 41 and 151 it was the practice of defendant and his predecessors to give timely notice of default in paying issue fees (see representative examples attached hereto as Exhibits A, B & C) and it is the present practice of defendant to give such notice (see representative example attached hereto as Exhibit D).

*Answer*

5. Defendant admits the allegations of this paragraph of the complaint, but defendant denies, that plaintiff had any statutory right to such notice or that failure to give plaintiff notice of default or abandonment violated any statutory or legal rights of plaintiff.

*Complaint*

6. On February 10, 1967, plaintiffs tendered and filed with the United States Patent Office said issue fee of $124 and a "Petition to Revive Abandoned Application" under the provisions of Title 35, USC, Section 133, and Rules 137 and 181 of the Patent Office Rules of Practice, asking defendant to revive said application and accept the tendered issue fee. Said petition was accompanied by the statutory fee of $15 for filing said petition and a verified showing of the reasons for the delay in paying said issue fee.

*Answer*

6. Admitted.

*Complaint*

7. The verified showing which was made by plaintiffs in support of said petition was adequate to satisfy defendant that the delay in paying the issue fee was unavoidable within the meaning of Title 35, USC, Section 133, but defendant on March 2, 1967, dismissed said petition on the grounds that Section 133 was not applicable and that defendant was precluded by 35 USC, Section 151 from accepting the issue fee more than three months after the due date even though the delay was unavoidable.

*Answer*

7. Defendant admits that the verified showing which was made by plaintiffs in support of the petition, referred to in paragraph 6 of the amended complaint, would be adequate to satisfy defendant that the delay in payment of the issue fee was unavoidable within the meaning of 35 USC 133, if that section were applicable but defendant denies that 35 USC 133 is applicable. Defendant admits that the petition was dismissed on the grounds alleged in this paragraph of the amended complaint.

*Complaint*

8. Defendant has the jurisdiction and right under Title 35, USC, Section 133 to revive said abandoned application, accept said issue fee and grant the patent.

*Answer*

8. Denied for reasons hereinafter given.

*Complaint*

9. The defendant has deprived plaintiffs of their property without due process of law in violation of the Fifth Amendment of the Constitution of the United States by

failing to give plaintiffs timely notice of said default in payment and by construing 35 USC, 151 to preclude a petition for revival under 35 USC, 133 more than three months after the default.

*Answer*

9. Denied for reasons hereinafter given.

*Complaint*

10. Defendant, in dismissing the petition of plaintiffs as aforesaid, has interpreted Title 35, USC in a manner which is clearly erroneous, unreasonable and arbitrary, not in accordance with law, short of plaintiffs' statutory rights, and without observance of procedure required by law.

*Answer*

10. Denied for reasons hereinafter given.

*Complaint*

11. The aforesaid action of defendant is a final agency action for which there is no other adequate remedy in a court.

*Answer*

11. Admitted.

*Complaint*

12. Plaintiffs, through unjustified loss of valuable patent rights and of their investment in said patent application, have suffered legal wrong because of the above-described action of defendant and are adversely aggrieved by said action under Title 35, USC.

*Answer*

12. Defendant denies the allegations of this paragraph of the complaint, respecting legal wrong done plaintiffs, because of defendant's action, and defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of this paragraph.

*Complaint*

13. Defendant has the ministerial duty under Title 35, USC, Section 133, to revive said abandoned application, accept said issue fee and grant the patent on a showing to his satisfaction that the delay in paying the issue fee was unavoidable.

*Answer*

13. Defendant denies the allegations of this paragraph of the amended complaint, for reasons hereinafter given.

Further Answering, defendant denies that plaintiffs are entitled to an order holding unlawful and setting aside defendant's denial of a petition to revive plaintiffs' application Serial No. 308,411, as requested in the prayers of the complaint, because the defendant is without authority under the law to revive said application, for the reasons set forth in the decision of the First Assistant Commissioner in said application. Profert of said decision is hereby made.

*Complaint*

Wherefore Plaintiffs Pray that this Honorable Court:

1. Hold unlawful and set aside said action of defendant dismissing plaintiffs' petition to revive the aforesaid abandoned application, and

2. Direct defendant to revive said abandoned application pursuant to the provisions of Title 35, USC, Section 133, accept said issue fee and issue Letters Patent on said application.

# In the Supreme Court of the United States

OCTOBER TERM, 1968

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No. 415

ROBERT J. EBBERT AND DESIGN PRODUCTS CORPORATION, PETITIONERS

*v.*

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

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*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT*

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## MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

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By "Notice of Allowance and Issue Fee Due" dated April 21, 1966, petitioners were notified (1) that their application for a patent had been allowed and (2) that, as a prerequisite to its issuance, an issue fee must be paid "within three months of the date of this Notice or the Patent will become abandoned (forfeited)" (Pet. 19). However, because of a clerical error by petitioners' counsel, timely payment was not

made.[1] The patent application was accordingly deemed abandoned under 35 U.S.C. (Supp. I) 151 (Pet. 3).

On February 10, 1967, almost seven months after it was due, the issue fee was tendered to the Commissioner of Patents, who rejected it on the ground that there was no statutory authority for the acceptance of a fee tendered after October 21, 1967—the expiration date of the three-month grace period provided by Section 151 (Pet. 13-14).[2] Petitioners then brought suit in the district court to compel acceptance of the fee and the issuance of the patent. The district court granted the relief (Pet. 15-17), but the court of appeals reversed (Pet. 18-25).

Petitioners' contention here is that the action of the Commissioner—and that of the court of appeals in upholding it—constitutes a deprivation of property without due process of law. The court of appeals correctly held, however, that the notice sent by the Patent Office, and concededly received by the petitioners, "fully satisfied due process requirements" (Pet. 23). The court applied the settled principle that notice satisfies due process if it is "reasonably calculated" to apprise parties of actions which they must take and gives a reasonable time for these actions to be taken. *Mullane* v. *Central Hanover Bank & Trust Co.*, 339 U.S. 306, 314-315. In this case, the notice plainly ap-

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[1] The fee was paid in another pending application by mistake (Pet. 27).

[2] Section 151 gives the Commissioner of Patents authority to accept late payment and revive the patent application *nunc pro tunc* if two conditions are met. First, the issue fee must be tendered within three months of the due date. Second, "sufficient cause" must be shown for the late payment.

prised petitioners (1) that the issue fee had to be paid within three months, and (2) that the application would be forfeited for non-payment. Indeed, failure to make payment here was caused, not by any deficiency in the notice, but by an error by petitioners' counsel. See *Link* v. *Wabash Railroad Co.*, 370 U.S. 626, 633-634.[3] As stated by the court below, "[t]he Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received" (Pet. 24).

The petition for a writ of certiorari should be denied.

Respectfully submitted.

ERWIN N. GRISWOLD,
*Solicitor General.*

SEPTEMBER 1968.

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[3] Contrary to petitioners' suggestion, the suspension of the Patent Office practice of notifying applicants of forfeitures did not vitiate the effectiveness of the original notice which petitioners concededly received. The Patent Office is not required to reiterate that an application has been forfeited after it has given adequate notice of the impendency of such forfeiture in the earlier "Notice of Allowance and Issue Fee Due".

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